



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,059	01/20/2004	Robert F. Day	PC11008C	4496
28523	7590	09/18/2006	EXAMINER	
PFIZER INC. PATENT DEPARTMENT, MS8260-1611 EASTERN POINT ROAD GROTON, CT 06340			CHANG, CELIA C	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 09/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

18

Office Action Summary	Application No. 10/762,059	Applicant(s) DAY ET AL.	
	Examiner Celia Chang	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

DETAILED ACTION

1. This application is a divisional of SN 10/379,976.

Claims 1-21 have been canceled. Claims 22-23 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 22 is rejected under 35 U.S.C. 102(b) as being anticipated by:

Cantello et al. CA110:135231,

RN 119670-22-3, when Y=CH₂, R5 is thiazolinyl, R6, R7 are oxo, R8=H;

Tsukamoto et al. CA 114:185549

RN 133155-44-9, 117826-24-1, 133155-50-7, 133155-51-8, 133155-52-9, 133155-53-0, 133155-54-1, Y is bond, R5 is pyridazinyl, R6 is oxo, R7 is H, R8 is alkyl or halogen;

Shutto et al. CA124:146167,

RN 172528-82-0, Y is CH₂, R5 is pyrazolyl, R6, R7, R8 are H;

Brenner et al. CA 128:294783,

RN206260-57-3, Y is bond, R5 is oxadiazolyl, R6 is aryl, R7, R8 are H.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 22 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by US

6,689,800.

See col. 17, compound I-4.

Art Unit: 1625

Claim 22 directed to the same invention as that of compound I-4 of commonly assigned US 6,689,800. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,689,800.

The anticipatory species of US 6,689,800 has been clearly pointed out supra. The one methyl addition compounds claimed by claim 23 would be obvious variation of the '800 compound. In re Wood 199 USPQ 137.

Since '800 did not claim the anticipatory compound, to obviate an obviousness rejection applicants must provide verification evidence i.e. 132 affidavit, that the subject matter was obligated to common assignment; the subject matter of '800 was derived from the instant application; and the instant and '800 are commonly owned at the time invention was made, i.e. a 103(c) condition.

Art Unit: 1625

5. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for R6, R7 are dimethyl, H/methyl or H/phenyl, does not reasonably provide enablement for the claimed scope. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The specification lacks description and enablement for the claimed scope of R6, R7 except when R6, R7 are dimethyl, H/methyl or H/phenyl. No example was found nor was any starting material for such moieties other than R6, R7 are dimethyl, H/methyl or H/phenyl were disclosed. Further more, the claimed intermediates are useful for making the final products which are β 3-adrenergic receptor agonistic compounds. The claimed scope of R6, R7 except when R6, R7 are dimethyl, H/methyl or H/phenyl, final products, such as one is alkyl, the other is substituted heterocycle have been evidenced to have inhibitory activity of cyclooxygenase (see CA 141:174163, RN 735266-38-3 CA 141:54327, RN 705935-39-3) i.e. improper Markush grouping.

Absent of any description and enablement of how to make such compounds when R6, R7 except when R6, R7 are dimethyl, H/methyl or H/phenyl, and absent of any evidence that such compounds share the common utility, the scope of enablement as claimed lacks support from the specification.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claim 22 is provisionally rejected under 35 U.S.C. 102(g) as being anticipated by US 2004/0116475 or US 2004/0157891.

Art Unit: 1625

See US 2004/0116475 claim 1 guided by compounds on page 45 ex.166-167, p.59, ex. 234-235 etc. (not exhausted listing) or see US 2004/0157891 claim 1 guided by compounds on page 23 ex. 61 etc. (not exhausted listing).

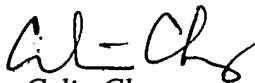
Please note that while applicants claims lacks descriptive and enabling support of the compounds described by '475 or '891, the explicit examples of the two pending claims anticipated the instant claim.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Sept. 14, 2006


Celia Chang
Primary Examiner
Art Unit 1625